

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SEUNG-HWAN OH

Appeal No. 2005-1780
Application No. 09/473,846

ON BRIEF

Before RUGGIERO, BLANKENSHIP, and MACDONALD, Administrative Patent Judges.
BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-4, which are all the claims remaining in the application.

We reverse, and enter a new ground of rejection in accordance with 37 CFR § 41.50(b).

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BACKGROUND

The invention relates to a method for processing an error in a received packet.

Claim 1 is reproduced below.¹

1. A method for processing a packet exceeding a predetermined size received from a physical layer by a MAC (Medium Access Control) layer of an Ethernet to be transmitted to a switch, the method comprising the steps of:

receiving a packet from the physical layer and transmitting the packet to a switch;

detecting for an error while transmitting the packet;

upon detection of the error, stopping the transmission of the packet in which the error is detected to the switch without waiting for a complete reception of the entire packet in which the error is detected; and

transmitting a signal indicating an occurrence of the error and a signal indicating an end of the packet to the switch.

The examiner relies on the following evidence:

Lo	5,493,562	Feb. 20, 1996
Haddock et al. (Haddock)	5,999,538	Dec. 7, 1999 (filed Jul. 2, 1997)
Itkowsky et al. (Itkowsky)	US 6,295,281 B1	Sep. 25, 2001 (filed May 16, 1997)

Appellant's Admitted Prior Art (AAPA).

Claim 1 stands rejected under 35 U.S.C. § 102 as being anticipated by Haddock.

¹ The claim reflects appellant's second amendment after final filed on July 2, 2004, which, according to the Examiner's Answer, the examiner has approved for entry.

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Claims 2 and 3 stand rejected under 35 U.S.C. § 103 as being unpatentable over AAPA and Lo.

Claim 4 stands rejected under 35 U.S.C. § 103 as being unpatentable over AAPA, Lo, and Itkowsky.

We refer to the Final Rejection (mailed Jan. 29, 2004) and the Examiner's Answer (mailed Nov. 15, 2004) for a statement of the examiner's position and to the Brief (filed Sep. 3, 2004) and the Reply Brief (filed Jan. 5, 2005) for appellant's position with respect to the claims which stand rejected.

OPINION

Rejections over the prior art

We reverse, pro forma, the rejections of the claims under 35 U.S.C. § 102 or 103 because we are unable to ascertain the scope of the claims for any meaningful comparison with the prior art. The reversal is for the reason that rejections of claims over prior art should not be based on speculation and assumptions as to the scope of the claims. See In re Steele, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962).

New ground of rejection

We enter the following new ground of rejection against the claims in accordance with 37 CFR § 41.50(b): Claims 1-4 are rejected under 35 U.S.C. § 112, second

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paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The function of claims is (1) to point out what the invention is in such a way as to distinguish it from the prior art; and (2) to define the scope of protection afforded by the patent. In re Vamco Mach., Inc., 752 F.2d 1564, 1577 n.5, 224 USPQ 617, 635 n.5 (Fed. Cir. 1985). The legal standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope. In re Warmerdam, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). The inquiry is merely to determine whether the claims do, in fact, set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). The definiteness of the language employed must be analyzed -- not in a vacuum, but in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id.

Instant claim 1 is internally inconsistent. The claim recites, in a first step, receiving a packet and transmitting the packet, and a related step (or sub-step) recites detecting for an error while transmitting the packet. Upon detection of the error, the claim recites stopping the transmission of the packet -- i.e., the packet that has been received and transmitted in the first step of the claim, which is detected for an error during the transmission. Appellant's disclosure does not teach or explain how the

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transmission of an already transmitted packet may be stopped. We compare present claim 1 to original claim 1, which recited: detecting error while receiving the packet from the physical layer; upon failure to detect the error, transmitting the received packet to the switch; and, upon detection of the error, stopping the transmission of the received packet to the switch.

Perhaps the intended meaning of claim 1 is, "receiving a packet from the physical layer and beginning transmission of the packet to a switch...." However, it is applicant's responsibility to ensure that the claims particularly point out and distinctly claim the subject matter which the applicant regards as the invention. While a patent application is pending and the claims can be amended, there is little reason for the difficulties related to speculation, assumptions, and attempts to divine an intended meaning. "An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process." In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

Moreover, if the claim were to be rewritten as we have indicated, in such a way to be consistent with the remainder of the claim, the disclosure does not appear to provide written description support for such a claim. Instant claim 1 was amended during prosecution (paper filed Nov. 14, 2003) to recite stopping transmission of the packet in which the error is detected to the switch "without waiting for a complete

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reception of the entire error packet....”² According to the remarks accompanying the amendment (p. 4), support for the feature “can be found at least in page 7, lines 6-17 [of the specification].”

The “without waiting” recitation seems to require, by implication, simultaneous reception and transmission of a packet. We read the specification section referenced by appellant as consistent with the steps recited in original claim 1. We find no express disclosure of the “without waiting” recitation, nor of simultaneous reception and transmission of a packet. If the “without waiting” recitation means that transmission of a packet in which an error is detected is stopped before complete reception of the packet by the device that is also transmitting the packet -- as apparently argued by appellant -- we find no clear support for the feature in the instant disclosure.³

The other independent claim before us, claim 2, contains language similar to that in claim 1 that we have addressed. We thus reject all the claims under 35 U.S.C. § 112, second paragraph.

² The clause was later amended to the current “without waiting for a complete reception of the entire packet in which the error is detected....”

³ We leave it for the examiner to determine if such a feature is inherently required by the disclosure’s description of the invention. Without express or inherent support for the feature in a claim passing muster under 35 U.S.C. § 112, second paragraph, the claim would be subject to a rejection under 35 U.S.C. § 112, first paragraph, because such disclosure lacks written description of the invention claimed.

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CONCLUSION

The rejection of claims 1-4 under 35 U.S.C. § 102 or 103 is reversed, pro forma.

A new rejection of claims 1-4 under 35 U.S.C. § 112, second paragraph is set forth herein.

This decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 CFR § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a). See 37 CFR § 1.136(a)(1)(iv).

REVERSED -- 37 CFR § 41.50(b)

Joseph F. Ruggiero

JOSEPH F. RUGGIERO)
Administrative Patent Judge)

Howard B. Blankenship

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